

REMARKS/ARGUMENTS

Rejection under 35 USC 112

Claim 13 has been rejected under 35 USC 112, second paragraph, as being indefinite. The Examiner points out two limitations which lack a proper antecedent lens. The dependency of claim 13 has been changed so that it depends from claim 2. Claim 2 contains a proper antecedent basis for both limitations. Thus, this rejection is now moot.

Summary of Rejection Over Prior Art

Claims 1, 12, 14, 15, 20, 31 and 33-35 have been rejected under 35 USC 102(b) as anticipated by Kiewit. Claims 2-11, 13, 16-19, 21-30, 32 and 36-39 have been rejected under 35 USC 103(a) as obvious over Kiewit in view of Thomas. Claims 2, 16, 21 and 36 have been rejected under 35 USC 103(a) as obvious over Kiewit in view of Weinblatt '807. Reconsideration and withdrawal of these rejections are respectfully requested in view of the claim modifications made herein and in light of the following remarks.

Rejection of Claims anticipated by Kiewit

All the claims which were rejected as anticipated by Kiewit have been canceled, without prejudice.

Patentability of claims over Kiewit and Thomas

The Examiner concedes that "Kiewit does not disclose the broadcast program is transmitted by the programming signal source in combination with a surveying code, and the stationary means further comprises third detecting means for detecting said surveying code and associating said surveying code with said identification signals." However, the Examiner contends that this gap is filled by Thomas. Issue is respectfully taken with the Examiner in this regard.

Thomas discloses a technique for embedding special identifying signals in audio and TV programs which are reproducible by speakers in radio and television sets as a series of tones, perhaps in a frequency that cannot be heard by the human ear. These tones are detected and stored by a portable device worn by persons within the sound of the TV or radio program containing these identification signals. The stored data is subsequently processed, possibly after being uploaded to a central processing facility, to identify the audience members.

Thus, the Examiner points out that Kiewit discloses a technique for identifying the audience members, and Thomas discloses a technique for identifying the program being watched or listened to by the audience. From this the Examiner reaches the following conclusion:

"Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to adapt the teaching of Thomas to Kiewit to monitor what program the audience is watching or listening to."

Why would the combination proposed by the Examiner be obvious, without the benefit of hindsight based on the present invention? The Examiner offers no support for making the combination other than to say, in effect, that A is known, B is known, so therefore AB is obvious. However, more than that is required under U.S. law and applicable PTO practice.

It must be noted, and fully appreciated, that Kiewit and Thomas address very different aims using different equipment which is operated in different ways to achieve different results. Thomas expresses no interest in knowing who is in the audience, and the apparatus disclosed therein includes only the TV/radio apparatus and the portable devices worn by the audience. The claimed "stationary means" of the present invention plays absolutely no role in Thomas. As to Kiewit, it expresses no interest in knowing what program is being watched or listened to. Nothing whatsoever can be pointed to in either one of these references to indicate some recognition of how the

interweaving of program monitoring and audience member identity monitoring can create a very powerful tool. It is only in the present application that this recognition is made.

It is well established based on extensive case law that in order to establish a *prima facie* case of obviousness, three basic criteria must be met, namely,

1. there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
2. there must be a reasonable expectation of success, and
3. the prior art references must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art. Even when the combination of the references includes every element of the claimed invention, without a motivation to combine, a rejection based on a *prima facie* case of obviousness was held improper. Al-Site Corp. v. VSI International, Inc., 50 USPQ 2d 161 (Fed. Cir. 1999).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ 2d 1430 (Fed Cir. 1990).

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. In re Kotzab, 55 USPQ 2d 1313, 1318 (Fed. Cir. 2000).

With all due respect, the Examiner's attention is invited to MPEP §§ 2143 and 2143.01.

The criteria essential to supporting an obviousness rejection have not been presented by the Examiner in order to support a rejection of independent claims 2, 16, 21 and 36 over the combination of Kiewit and Thomas. All of these independent claims include the combination of obtaining identification data for an audience member from a portable device and detecting a survey code transmitted in a broadcast program. Accordingly, it is respectfully submitted that all of the claims remaining in the present application are clearly and patentably distinguishable thereover.

Claims 2, 16, 21 and 36 have been rejected under 35 USC 103(a) as being obvious over Kiewit in view of Weinblatt '807. The Examiner correctly indicates that this rejection can be overcome for applications filed on or after November 29, 1999 by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This is in fact the case with the present application. The Weinblatt '807 patent is owned by Mr. Weinblatt. The present application is also completely owned by Mr. Weinblatt in view of an assignment from the joint inventor to Mr. Weinblatt which was duly recorded on Reel 010631, Frame 0466 on March 6, 2000. Accordingly, removal of the Weinblatt '807 reference is in order.

Based on all of the above, it is respectfully submitted that the present application is now in proper condition for allowance. Prompt and favorable action to this effect is respectfully solicited.

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By Express Mail #EV542421993US

Should the Examiner have any comments, questions, suggestions or objections, he is invited to telephone the undersigned in order to facilitate reaching a resolution of any such outstanding matters.

Respectfully submitted,
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